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OFFICE OF PETITIONS

In re Application of :
Asundi et al. :
Application No. 10/084,643 : ON PETITION
Filed: 26 February, 2002 :
Attorney's Docket No. 21272-502 :

This is a decision on the petition filed under 37 CFR 1.53 on 18 June, 2002, which is treated as a petition requesting that the Notice to File Missing Parts of Nonprovisional Application mailed on 9 May, 2002, be withdrawn to the extent that it stated that Pages 213-679 and 1176-9856 of the specification appeared to have been omitted.

The petition is **dismissed**.

It is not clear whether petitioners have responded to the Items Required To Avoid Abandonment as listed on the abovementioned Notice. If the items required by the Notice to avoid abandonment (e.g., an executed oath or declaration and substitute specification in compliance with 37 CFR 1.52), have not been timely filed, the application is **abandoned**, and a petition to revive, accompanied by the required items and a petition fee, must be filed.

On 26 February, 2002, the above-identified application was filed. The application papers included, *inter alia*, Pages 1-212 of written description, Pages 680-944 consisting of tables, Pages 10-1032 consisting of tables, Pages 9857-10960 consisting of tables, Pages 10961-10966 of claims, and a Compact Disc (CD).

Accordingly, on 9 May, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application stating, *inter alia*, that Pages 213-679 and 1176-9856 of the specification (description and claims) appeared to have been omitted from the application. As discussed below pages 945-1031 are also omitted in paper but were not identified as being omitted in the Notice to File Missing Parts.

In response, on 18 June, 2002, the present petition was filed. Petitioners assert that Pages 213-679, 945-1031 and 1176-9856 were not missing on 26 February, 2002, but consisted of tables deposited in electronic format on the CD pursuant to 37 CFR 1.52(e)(1)(iii).¹

Petitioners are reminded that the pages of the specification including claims and abstract must be numbered consecutively, starting with 1.²

The Office of Initial Patent Examination (OIPE) reviews compact discs to verify that the contents of the compact discs match the file descriptions in the specification and transmittal letter as required by 37 C.F.R. §§1.52(e)(3)(ii) and 1.52(e)(5). The files submitted on compact disc are required to be in ASCII files which have no intrinsic page numbering. See 37 C.F.R. §1.52(e)(3)(I). The files submitted are not ASCII files (the petition indicates they are Microsoft Word 2000 format files). There is no intrinsic page numbering in ASCII files and no requirement to number the pages of a table on compact disc. The Office does not print the files received on compact disc and attempt to assemble them into the page order applicant intended as suggested in the petition. Hence there is no OIPE review of page numbers for table pages of the files submitted on compact disc. See MPEP §608.05. Since the specification and transmittal letter failed to contain the compact disc descriptions required by 37 C.F.R. §§1.52(e)(3)(ii) and 1.52(e)(5), no verification of the compact disc contents can be made by OIPE.

While it is obvious from the petition that the application elements identified as missing on 9 May, 2002 were intended to be on the compact disc as described above it cannot be verified that the material is in fact in the files submitted on compact disc. The Office can acknowledge the receipt of compact discs, but the Office cannot acknowledge that the material on the compact discs is what applicant intended to be submitted.

If applicant believes that material on the compact disc is what was intended to be submitted then applicant may constructively elect to accept the application as deposited and the Office will treat the specification as mispaginated as a result of the

¹Petitioners assert that Pages 945-1031 were also provided in electronic format. As discussed later in this decision the Office does not review page numbering of the files contained on a CD.

²37 CFR 1.52(b)(5).

applicant's filing error. No further petition (however, note the new requirement infra.) would be required, but a preliminary amendment of the specification is required to renumber the pages of the application consecutively. See MPEP 601.01(e).

However, the "Notice" mailed on 11 July, 2000, was correct in stating that Pages 213-679 and 1176-9856 described in the specification appeared to have been omitted. Therefore, the "Notice" was properly mailed and will not be withdrawn except as described in the preceding paragraph.

As the present petition was not necessitated by any error on the part of the Office, the \$130.00 petition fee will not be refunded.

A review of the application reveals that the application was filed with a "REQUEST FOR TRANSFER OF SEQUENCE LISTING UNDER 37 C.F.R. § 1.821(e)" which in the last paragraph requests the use of the "...paper copy of the Sequence listings of applications as the paper copy of this application." There is no provision for transferring the paper (or compact disc) sequence listing required by § 1.821(c) to another application. The Notice to File Missing Parts dated May 9, 2002, should have included the following additional item:

This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing"; as required by 37 C.F.R. § 1.821(c). Applicant must provide an initial paper or compact disc copy of the "Sequence Listing" as well as an amendment directing its entry into the application and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR §§ 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000).

Applicant is given TWO MONTHS from the mailing date of this decision to for response to the the sequence listing noted file the sequence listing in compliance with 37 § CFR 1.821(c) required above. Failure to timely reply will result in abandonment of the application. Extensions of time under 37 C.F.R. § 1.136(a) are available. A preliminary amendment of the

specification to renumber the pages of the application consecutively should also include an amendment to add proper references to the material on compact disc in compliance with 37 CFR § 1.52(e)(5) prior to the first Office action to avoid delays in the prosecution of the application. The response should be directed to Initial Patent Examination Division.

The application is being returned to the Office of Initial Patent Examination to await the response to this decision including the sequence listing required above.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6918.



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Office of Petitions